REMARKS

Reconsideration of the rejections set forth in the Office action dated 3/16/2005 is respectfully requested under the provisions of 37 CFR §1.111(b).

Claims 1-16 are pending

Claims 9-16 have been withdrawn

Claims 1-3 and 7 stand rejected

Claims 4-6 and 8 have been objected to.

Applicant includes a petition for a one-month extension of time.

All references to the specification are by paragraph number of the substitute specification filed responsive to the office action dated 10/27/03.

No amendments were made to the claims.

Applicant thanks the Examiner for the indication of allowability for claims 4-6 and 8.

I. Rejections under 35 USC § 102(b)

Claims 1-3 stand rejected under 35 USC § 102(b) as being anticipated by Petrie (US 5,611,575).

A prima facie case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (arranged as in the claim) expressly or inherently as interpreted by one of ordinary skill in the art.

Applicant respectfully traverses the rejection of claims 1-3 as a prima facie case has not been established.

Previously presented claim 1 is directed to an embedded data code on a substrate, comprising:

> periodic tiles, each tile comprising
> a predefined code area having a code pattern common to the other tiles; and
> a predefined occlusion area not necessary for decoding the code pattern, the predefined occlusion area having the same location and shape in the periodic tiles.

Looking at figures 2 and 3 for example:

In figure 2 and paragraph [0036], the term "periodic tiles" refers to a regularly repeating (both horizontal and vertically) glyph tile. The glyph codes in each of the repeated glyph tiles having a common code pattern (the code patterns are identical). The code pattern in the code area in each tile needs to be identical to reconstruct the in the code area when an image capture window is positioned across tiles [0005].

Figure 3 and paragraph [0038] show periodic tiles that have a code area and an occlusion area. The glyph codes in the code area are common in each of the repeated glyph tiles. The occlusion area has the same shape and location in each of the periodic tiles.

Petrie discloses addressing techniques for embedded data blocks within a frame block in the context of a lattice framework. The office action cites Petrie (column 7, lines 54-67) as teaching periodic tiles (indicating 72) and having a code pattern common to other tiles. However, the cited text and figure illustrate a single frame block and no information is provided about the data contained in the data block (although, information is provided about the addressing/sync data at the boundary of the frame block). Hence, nothing in column 7 lines 54-67 teach tiles having a common code pattern. At most, this citation can only be read as stating that each of the frame blocks have glyphs that are distributed over a regular grid pattern. It teaches nothing about the data encoded by the glyphs in the data portion of the frame block.

Petrie does teach that the codes in the embedded data blocks are not common among the embedded data blocks (for example, see Petrie column 10, line 65 thru column

11, line 12, that teaches that some of the embedded data blocks will be different from other embedded data blocks responsive to the flag that indicates some of the data in the embedded data block is different when the flag is set vs. not set).

The office action cites column 10, line 65 thru column 11, line 12, as teaching a predefined occlusion area not necessary for decoding the code pattern.

Figure 8 illustrates a frame block that is comprised of glyphs. The boundary of the frame block contains addressing data (column 8, lines 3-7) and can also include a flag indicating whether the frame block contains special processing codewords (column 8, lines 10-15). Figure 11 illustrates a frame block where the flag is set thus enabling the special processing codeword. Thus, the frame block can contain the special processing codeword or not depending on the state of the flag.

Thus, for some frame blocks, all of the glyphs internal to the frame block are used for data, and in other frame blocks some of the glyphs internal to the frame block are used for data while the remaining glyphs internal to the frame block are used as a special processing codeword. Hence, Petrie does not teach a predefined occlusion area having the same location and shape in the periodic tiles.

Therefore:

- Nothing in Petrie teaches "a code pattern common to the other tiles"
- Nothing in Petrie teaches "a predefined occlusion area having the same location and shape in the periodic tiles"

Thus, applicant respectfully traverses the 102(b) rejection to presently presented **claim 1**. Claims 2 and 3 depend on and further limit claim 1 and so are also not anticipated. Thus, applicant respectfully traverses the 102(b) rejection to **claims 2 and 3**. In addition, with respect to claim 3, Petrie does not teach a predefined occlusion area and thus applicant accordingly respectfully traverses the rejection of claim 3.

II. Rejections under 35 USC §103(a)

Claim 7 stands rejected under 35 USC §103 as being unpatentable over the combination of Petrie (5,611,575) and Hecht (6,000,621). This rejection is respectfully traversed in view of the following arguments.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

Claim 7 depends on and further limits previously presented claim 1 that is patentable. Thus, claim 7 is also patentable. In addition, Hecht figures 5 and 6 show tiles (each having a common code pattern) that are not contagious (column 3, lines 29-36; column 6, lines 18-24). The same tiles are shown in a contiguous arrangement in figure 7 (column 3, lines37-39). None of these tiles have a predefined occlusion area. Instead, the tiles are placed so that there is additional space between each tile. Nothing in Petrie or Hecht would teach a suggestion to combine them to one skilled in the art.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

The undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

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